

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

### REMARKS

The following remarks are submitted in response to a US Patent and Trademark Final Office Action dated January 2, 2008.

Claims 7, 9-11, 13-16 and 18-36 are pending in the application. No amendments to the claims have been made.

### Finality of Office Action

Applicants respectfully request reconsideration of the finality of the Office Action and its withdrawal. It is submitted that the finality of the Office Action is premature, at least for the following reasons:

1. The following is quoted from MPEP §707.07(f):

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Applicants' arguments have not been fully responded to by the Examiner. For example, Applicants argued regarding independent claim 11 as follows: "Claim 11 is not *prima facie* anticipated for yet another reason." It contains the limitation of "collecting the hair cuttings from the skin of the user. In Kelman, the hair cuttings are never deposited on the skin of the user. Rather the collection is made entirely inside the housing. Thus, there is no such act taught by Kelman." The Examiner has not responded to Applicants' argument but rather repeated the rejection of the First Office Action in the case without taking note of applicants' arguments.

2. Applicants quote from MPEP §703.07(a):

"A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed."

New prior art was cited by the Examiner against claims amended to include limitations which should not only have been anticipated by the Examiner, but which actually were anticipated by the Examiner. In the rejection in the prior action the Examiner rejected claim

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

16 under 35 U. S. C. §112 in that the word "electrically" lacked antecedent basis. This word was changed to "electrostatically" to match the wording in parent claim 11. Claim 16 was amended by Applicants for correction of antecedent only. That the Examiner examined the claim as though it said "electrostatically" is clear from the previous rejection of claim 16 which stated:

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman (International Publication No. WO/92/16338) in view of Pragt (U.S. Publication No. 2001/0015016).

Kelman discloses all of the limitations of the claimed invention, as previously set forth, except for the electrostatically charged element being charged by friction of the element with the skin of a user as it is moved along the skin.

However, an electrostatically charged element being charged by friction as it is moved along the skin is known in the art. Pragt teaches a shaving apparatus (9) a manipulator (10) that is adapted to move hair along the cutting edge (page 1, paragraph 1; see Figure 1). In addition, Pragt teaches the manipulator comprising a material,

Clearly, the Examiner has referred to the claim as if amended showing conclusively that the Examiner (at least) anticipated that the change that was made would be made. Nevertheless, the Examiner has cited new prior art against claim 16 in the pending final action.

It is interesting to note that the very rejection in the present Office Action follows the previous rejection closely:

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

8. Claims 16 and 18-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman (International Publication No. WO/92/16338) in view of Birmingham (U.S. Patent No. 3,045,345).

Kelman discloses all of the limitations of the claimed invention, as previously set forth, except for the electrostatically charged element being charged by friction of the element with the skin of a user as it is moved along the skin.

However, an electrostatically charged element being charged by friction as it is moved along the skin is known in the art. Birmingham, for example, teach a shear plate (14) constructed of a dielectric material that is adapted to develop a static electrical

The change in art was clearly made for another reason, and not because of Applicants' amendment.

Applicants file herewith a Notice of Appeal and Pre-Appeal Brief in response to the Final Office Action. However, since the finality of the Office Action is premature, Applicants respectfully request that the finality of the Office Action dated January 2, 2008 be withdrawn.

#### **Claim Rejections - 35 U.S.C. §102**

Claims 7, 10, 11, 13, 15 and 17 stand rejected under 35 U.S.C. §102(b) as anticipated by Kelman (WO Publication No. 92/16338). Applicants respectfully traverse the rejection. Furthermore, Applicants submit that the Examiner has not set out a *prima facie* anticipation with respect to at least claim 7 and certainly not with respect to claim 11 since Kelman fails to disclose at least one feature of each of these claims.

Claim 7 requires "a heated elongate element heated to a temperature sufficient to cut hair, mounted on the structure". According to the Examiner, the heated elongate element of claim 7 is shown in Kelman as laser beam 18 which is a physical element producing a physical effect onto the hair.

The rejection (on page 3) reads:

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

"With respect to the limitation of a heated elongate element, Kelman discloses a laser beam (18) that is used to cut hair (Abstract). A laser beam is an elongate beam of light that is amplified by stimulated emission of radiation. Kelman further disclose the hair being vaporized or carbonized at the location of impingement of the laser beam (18) thereon (page 5, lines 18-24). To carbonize hair by a laser beam (18) would involve a burning/heating since the laser beam (18) light is not carbonizing by a chemical process or by fossilization."

Firstly, Applicants contend that even accepting that a laser beam is an elongate *element* (which applicants do not), it is not heated to any temperature. The concept of temperate is completely foreign to electromagnetic radiation itself which can transmit energy but which does not have any temperature.

This is connected with the fact that the laser beam is not an element and certainly not a physical element as contended by the Examiner, except in the context of wave-particle duality. But even if it is considered to comprise photons which carry energy, these photons are not elongate elements and do not have a temperature. If one is looking for some *physical* element in a laser beam it is anything but elongate. Even the various portions of the beam (considered as electromagnetic radiation) are not connected as such.

Applicants note that, in general, an attempt by an applicant to claim a laser beam, *per se*, as an element in a claim results in a rejection under 35 U.S.C. §112.

There is no temperature related to a laser beam. Temperature is a measure of the hotness of an object measured on a definite scale. (Merriam Webster). There is no such scale for or such concept for lasers or other electromagnetic energy. Even when temperature is used for colors, it is actually a reference to the color of light emitted by a heated body. It is never utilized for lasers, since they have a single wavelength.

Lasers do not produce heat *per se*. Rather they produce electromagnetic energy that heats an object that absorbs it. The laser itself is not hot at all. Thus, laser beam 18 of Kelman is composed of electromagnetic radiation that heats an object that absorbs it. The electromagnetic radiation is what provides the effect of cutting to the hair that absorbs the laser beam. However, the beam itself is not hot. Since temperature is a characteristic of the element itself and not of its effect on other objects, under the Examiner's definition, the temperature of the laser beam would be zero when it is in vacuum (since it does not transfer any energy). Further, under this definition, the laser beam has a low temperature in air (since it does not heat the air to a temperature sufficient to cut hair) and has the claimed temperature only when it touches hair. Applicants submit that this could not be considered a characteristic

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

of the heated elongate element (as claimed). In order for the element to meet the claim the temperature has to be that of the element, independent of whether it is actually cutting hair. It will have this temperature wherever it is measured. However, applicants reiterate that they believe that the Examiner's definition is incorrect and that an electromagnetic beam does not have a temperate, by any reasonable accepted definition.

Moreover, even if one would interpret a laser beam to be a hot element, the beam is not a *heated* element as recited in the claim, since a heated element is only possible of interpretation as an element which is present even when not heated. However, laser beam 18 of Kelman does not exist in what the Examiner would like to consider an unheated state. The very existence of the beam (the examiner's interpretation of elongate element) is predicated on the existence of the photons. Absent the photons, the "elongate element" does not exist. It is difficult to see how one can heat an element, which even according to the Examiner's definition, does not exist in unheated form.

Claim 11 includes a similar limitation. In addition, claim 11 is not *prima facie* anticipated for yet another reason. It contains the limitation of "collecting the hair cuttings from the skin of the user." In Kelman, the hair cuttings are never deposited on the skin of the user. Rather the collection is made entirely inside the housing. Thus, there is no such act taught by Kelman. It is noted that the electrostatic collection of Kelman would in the position shown in Kelman, be unable to remove hair from the skin, after the hair is cut. In Kelman, the objective of hair collection is to keep the hair from being deposited on the skin or inside the space containing the laser beam.

The dependent claims are patentable at least by virtue of their patentable parent claims.

### **Claim Rejections – 35 U.S.C. §103**

Claims 9 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelman in view of Inderosa (US Patent No. 5,065,515). Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since a combination of Kelman and Inderosa would not result in claims 9 and 14.

Kelman describes a hair cutting apparatus where the hair is cut by a laser beam. For this use, the Examiner contends that it would have been obvious to replace the beam of Kelman with the pre-heating element of Inderosa, since Inderosa teaches that pre-heating can be by a heated metallic element or a laser. However, there is no teaching of such functional

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

equivalence in the context of heating the hair to a temperature high enough to destroy it. Kelman realized, as would any person of the art that utilizing the metallic heated element shown in Inderosa for cutting purpose would destroy the skin together with the hair.

In fact, the very wording of claims 9 and 14 distinguish over the element of Inderosa. The claims define the heated element as a "wire." There is no wire in Inderosa. The metallic element of Inderosa is a rather large element with a large heat capacity. It needs to have this large heat capacity so that it can transfer enough energy to the skin without cooling off. However, if such a structure were used to replace the laser of Kelman, and heated to a temperature as presently claimed, the skin would be burned. There is just no way to utilize the heated metallic element of Inderosa to cut hair. The most it can do is to pre-heat and soften the hair, which is why it is followed by a blade in Inderosa.

A person of ordinary skill in the art, reading Inderosa, would understand that in order to reach a relatively low heating of the hair, i.e. not high enough for it to be cut, laser or metallic element heating may be equivalents. However, when hair is to be cut by the radiation or heat, the hair should reach a substantially higher temperature and the metallic element of Inderosa would not be suitable.

Thus, a combination of the references could at best result in a device where the hair is preheated by a metallic heated element and then cut by a laser beam. It is not clear why anyone would want to do this, but replacing the laser beam of Kelman by the metallic element of Inderosa, even with raising its temperature is not obvious since it would not work. Applicants submit that the combination of the references fails to disclose the feature of "a heated elongate element heated to a temperature sufficient to cut hair" in claim 9 and the similar feature in claim 14.

Claims 16 and 18-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kelman in view of newly-cited Bermingham (US Patent Nol. 3,045,345). Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since the combination of the references would not result in the claimed invention.

Claims 16 and 18-36 all depend, directly or indirectly, on independent claims 7 and 11 and are patentable for the same reasons as those claims. The dependent claims refer to different features but are rejected over the same combination by the Examiner. In addition at least claims 19-22, 25-28, 31-34 and 36 contain features which are not *prima facie* taught by the references either alone or in combination.

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

What appears to be common to the rejections is that the Examiner combines Kelman and Bermingham in a way that the electrostatically charged element of Kelman is replaced with the electrostatically charged element of Bermingham. Applicants respectfully disagree with the combination and submit that if one would combine Kelman and Bermingham the combination would not replace the electrostatically charged element of Kelman but rather add the electrostatically charged element of Bermingham to the device of Kelman. Therefore, the combination would not result in the claimed inventions.

The electrostatically charged element of Kelman as referred to by the Examiner is adapted to collect cut hair from within the chamber through which the beam passes.

Bermingham describes an electrical shaver which develops a static electrical charge by friction to provide an attracting force for the hairs to be cut and tends to set them in an optimum cutting position, see col. 2, lines 36-40. Thus, the electrostatically charged element in Bermingham is moved along the skin before the hair is cut and is adapted to prepare the hair for cutting. Thus, if one would combine Kelman and Birmingham, the result would be Kelman's shaving device with the *addition* of an electrostatically charged element which is moved on the skin before the laser beam. While such a feature might be useful in Kelman, it is clearly different from the rejected claims.

It is further noted that in Kelman, the collection of the hair is made entirely in the device and the hair cuttings are never deposited on the skin of the user. Therefore, there would be no use for an electrostatically charged element as recited in the claims.

Thus, the combination suggested by the Examiner would not result in the rejected claims. In addition, the Examiner has not referred to all the features of the rejected claims.

For example, claims 19, 21, 25, 27, 31, and 33 (and claims dependent on them) recite "the electrostatically charged element contacts the skin after the hair has been cut," or similar wording. The Examiner did not specifically related to this limitation in his rejection. However, as stated above, the electrostatically charged element in Kelman does not contact the skin and the element in Bermingham contacts the skin before hair has been cut. Accordingly, the prior art fails to teach the elements of claims 19-22, 25-28, and 31-34. Neither reference teaches removing cut hair from the skin as required by claim 36.

In re Application of: Pinchas SHALEV et al  
Serial No.: 10/535,536  
Filed: May 18, 2005  
Final Office Action Mailing Date: January 2, 2008

Examiner: Stephen J. RALIS  
Group Art Unit: 3742  
Attorney Docket: 35746

**Double patenting**

Claims 7, 8, 11 and 12 stand provisionally rejected on the grounds of non-statutory obviousness type double patenting as being unpatentable over claim 1 of copending Patent Application No. 11/571,753. Applicants note that the claims in the other application have not yet been examined, so that the scope of claims that will issue from the other application are not known.

**Conclusion**

In view of the above remarks, applicant submits that the finality of the Office Action should be revoked and that the claims are patentable over the prior art. Allowance of the application is respectfully awaited.

Concurrently with this paper Applicants are filing a Notice of Appeal and a Pre-Appeal brief. In addition to the arguments for patentability which applicants are making in that paper, Applicants are requesting in this paper that the finality of the rejection be withdrawn and are arguing the propriety of the request for a terminal disclaimer. These issues are not considered to be appropriate for a Pre-Appeal Brief. If finality is withdrawn the Appeal will be moot and will be withdrawn.

In addition, it is Applicants' intention to request a personal interview in early June when the undersigned is in Washington.

Respectfully submitted,

*Paul Fenster*

Paul Fenster  
Registration No. 33,877

Date: April 2, 2008